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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,023	03/25/2004	John R. Squilla	86901F-P	7820

7590 04/16/2008
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EXAMINER

ANTONIENKO, DEBRA L

ART UNIT	PAPER NUMBER
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4194

MAIL DATE	DELIVERY MODE
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04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/809,023	Applicant(s) SQUILLA ET AL.	
	Examiner DEBRA ANTONIENKO	Art Unit 4194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/25/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).
2. Claim 8 is dependent on Claim 6, but is separated by Claim 7.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. In Claim 1, the term "automatically" renders the limitation vague and indefinite.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention (i.e., a process, machine, manufacture, or composition of matter).

In the present case, Claim 1 recites a method for generating a product comprising the steps of providing, associating, and forwarding. This method is merely an abstract idea that does not involve any structural means or computer to carry out the process.

Therefore, the process as claimed is not considered to be patentable subject matter.

Claims 2-17 are dependent on Claim 1 and are rejected in a like manner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 10, 11, and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaffer et al., U.S. Patent Number 6,396,963 B2 (hereinafter referred to as Shaffer).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire

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reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Regarding Claim 1:

Shaffer teaches a method for automatically generating a custom image product by a service provider for a customer, said custom image product having at least one image captured on image bearing medium by said customer and associated related content provided said service provider, said associated related content relating to an event or to a venue where said at least one image was captured, comprising the steps of:

providing a form that includes information that is be used for identifying said associated related content (column 4, lines 43-48; column 10, lines 35-36);

associating said form with respect to a image bearing medium product having at least one exposed image (column 4, lines 35-52);

forwarding said form and associated image bearing medium to said service provider, said service provider using said information from said form to obtain said related content in digital form and associating said related content in digital form with respect to at least one digital image obtained from said at least one image (column 4, lines 6-16 and lines 35-52); and

said service provider providing said image product which incorporates said at least one image from said image bearing medium and said related content (column 2, lines 44-47).

Regarding Claim 2:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said related content incorporates at least one image (column 4, lines 35-52; column 5, lines 35-46).

Regarding Claim 3:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said form further includes a plurality of different selectable information that can be used for identifying said associated related content (column 4, lines 35-52).

Regarding Claim 10:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said form is incorporated into a photofinishing order bag (column 4, lines 43-46).

Regarding Claim 11:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said product incorporates a feature for separating at least one image (Figure 9).

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Regarding Claim 13:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said image bearing medium comprises photographic film (column 3, lines 46-48).

Regarding Claim 14:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said image bearing medium comprises a flash memory card of a digital camera (Figure 1).

Regarding Claim 15:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said image bearing medium comprises a print (Figure 1).

Regarding Claim 16:

Shaffer teaches the limitations of Claim 1 as described above.

Shaffer further teaches wherein said image bearing medium comprises a photographic negative (column 3, lines 46-48).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4, 5, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Cipolla et al., U.S. Patent Number 6,275,656 B1 (hereinafter referred to as Cipolla).

Regarding Claim 4:

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As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said form further includes a machine readable code that allows automatic association with said image bearing medium.

However, Cipolla discloses wherein said form further includes a machine readable code that allows automatic association with said image bearing medium (column 6, lines 7-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Cipolla's use of machine readable code into Shaffer's method in order to allow for efficient processing.

Regarding Claim 5:

As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said image bearing medium is provided in a one time use camera.

However, Cipolla discloses wherein said image bearing medium is provided in a one time use camera (column 6, lines 21-25). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Cipolla's accommodation of one time use cameras into Shaffer's method in order to offer the customer a variety of options.

Regarding Claim 9:

As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said form includes indicia for orienting said form with a reader so that said information can be machine read from said form.

However, Cipolla discloses wherein said form includes indicia for orienting said form with a reader so that said information can be machine read from said form (column 9, lines 32-56). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Cipolla's use of machine readable code into Shaffer's method in order to allow for efficient processing.

Regarding Claim 12:

As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said related content is associated with the event or site where said form is available.

However, Cipolla discloses wherein said related content is associated with the event or site where said form is available (column 12, lines 2-9). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Cipolla's method of making the invention available at events and other sites into Shaffer's method in order to maximize marketing of product.

11. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Johnson et al., U.S. Patent Application Number 2003/0059586 A1 (hereinafter referred to as Johnson).

Regarding Claim 6:

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As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said form is provided on a sticker.

However, Johnson discloses wherein said form is provided on a sticker ([0013]-[0015]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Johnson's use of stickers into Shaffer's method in order to offer the customer an easy way to denote information.

Regarding Claim 7:

As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said form is provided on a sticker on a single use camera.

However, Johnson discloses wherein said form is provided on a sticker on a single use camera ([0013]-[0015]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Johnson's use of stickers into Shaffer's method in order to offer the customer an easy way to denote information.

Regarding Claim 8:

As described above, Shaffer teaches the limitations of Claim 1. Shaffer and Johnson teach the limitations of Claim 6. Shaffer does not explicitly disclose wherein said sticker is associated on a container for holding said image bearing medium.

However, Johnson discloses wherein said sticker is associated on a container for holding said image bearing medium ([0013]-[0015]). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Johnson's use of stickers into Shaffer's method in order to offer the customer an easy way to denote information.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Gindele et al., U.S. Patent Number 6,748,097 B1 (hereinafter referred to as Gindele).

Regarding Claim 17:

As described above, Shaffer teaches the limitations of Claim 1, but Shaffer does not explicitly disclose wherein said image bearing medium comprises a photographic transparency.

However, Gindele discloses wherein said image bearing medium comprises a photographic transparency (column 5, lines 45-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Gindele's acceptance of transparencies into Shaffer's method in order to offer the customer a variety of options.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBRA ANTONIENKO whose telephone number is

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(571)270-3601. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Debra Antonienko/
Examiner, Art Unit 4194
04/14/2008

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4194